

REMARKS

Claims 35 and 36 are pending in this application.

As a preliminary matter, Applicants noted that the PTO-1449 form submitted with an Information Disclosure Statements filed on August 29, 2000, and October 24, 2002, were not initialed and returned by the Examiner. Applicants respectfully request the references cited in these Information Disclosure Statements be considered and the PTO-1449 form be initialed and returned with the next communication.

Claims 35 and 36 are pending in this application. Claims 35 and 36 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fisher (U.S. Patent No. 5,005,200) in view of Payne et al. (U.S. Patent No. 5,715,314). Reconsideration is respectfully requested.

The Final Rejection contends that Payne et al. clearly teaches determining if sufficient funds or credit are present, and therefore, to one of ordinary skill, the payment computer of Payne et al. is a register having funds stored therein. Applicants respectfully disagree.

Payne et al. is directed to network-based sales system that includes at least one buyer computer for operation by a user desiring to buy a product, at least one merchant computer, and at least one payment computer. The computers are interconnected by a computer network. Although Payne et al. describes a step in which the payment computer verifies whether the user account has sufficient funds or credit (step 76 of Fig. 2G), there is no disclosure, teaching or suggestion in Payne of any type of register with funds stored therein. In fact, the only type of account ever described anywhere in Payne et al. is a conventional credit card account. Note that Fig. 7 of Payne et al. that illustrates a screen snapshot of a new account document that the payment computer sends to the buyer computer when the buyer desires to open a new account. The buyer must complete this document to make a purchase utilizing the system of Payne et al. As illustrated, the user must input a credit card

number and expiration date, and also indicate if they are the owner of the credit card. The user must also provide an account name and password that will be linked to the credit card account. (See Col. 6, lines 15-42). If the user already has an account, the user must provide the account name and password which were previously associated with the buyer's credit card when the account was opened. This credit card account is the only type of account disclosed, taught or suggested by Payne et al.

The Office Action has not provided any motivation for taking the credit card payment system of Payne et al., modifying it to include a register having funds stored therein, and then using the funds in the register to obtain cryptographic certificates. Without using the present claims as a road map, it would not have been obvious to make the multiple, selective modifications needed to arrive at the claimed invention from these references. The rejection uses impermissible hindsight to reconstruct the present invention from these references. See Ex parte Clapp, 227 U.S.P.Q. 972,973 (Bd. App. 1985) (requiring "convincing line of reasoning" to support and obviousness determination).

Furthermore, the Office Action states that it would have been obvious to combine Fisher and Payne et al. to arrive at the present invention, since by having an independent payment computer (e.g. a bank) verify a user's ability to pay prior to completing a transaction a merchant, such as a certificate authority, can guarantee compensation for services rendered.

The present invention, however, is not directed to having an independent payment computer verify a user's ability to pay and therefore guarantee compensation for services rendered. According to the present invention, a certificate meter provides certificate management services including use of cryptographically secured certificates. Payment for the processing and issuing, by the certificate authority, of the electronic certificates can be made using funds stored in the meter. Thus, the present invention provides a party to an electronic commerce transaction access to a secure cryptographic device, i.e., a certificate meter, associated with a

certificate authority, while providing the certificate authority with a convenient payment system to allow the certificate authority to get paid for processing and issuing of the electronic certificates. In view of this, claim 35 is directed to a method for "obtaining a cryptographic certificate" that comprises the steps of "providing a register having funds stored therein; determining if sufficient funds are present in the register for obtaining the certificate; sending a certificate request to a certificate authority; receiving the cryptographic certificate from the certificate authority; and deducting funds from the register for obtaining the requested certificate."

The fact that the present invention was made by the Applicants does not make the present invention obvious; that suggestion or teaching must come from the prior art. See C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352 (Fed. Cir. 1998). See, e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051-1052 (Fed. Cir. 1988) (it is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation in the prior art to do so). "Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in a way they were combined by the inventor." ATD Corp. v. Lydall, Inc., 159 F.3d 534, 545 (Fed. Cir. 1998) (emphasis added). No such suggestion or motivation has been provided by the Office Action to arrive at the present invention from these references.

For at least the above reasons, Applicants respectfully submit that claim 35 is allowable over the prior art of record.

Claim 36, dependent upon claim 35, is allowable along with claim 35 and on its own merits.

In view of the foregoing remarks, it is respectfully submitted that the claims of this case are in a condition for allowance and favorable action thereon is requested.

Respectfully submitted,



Brian A. Lemm
Reg. No. 43,748
Attorney for Applicants
Telephone (203) 924-3836

PITNEY BOWES INC.
Intellectual Property and
Technology Law Department
35 Waterview Drive
P.O. Box 3000
Shelton, CT 06484-8000